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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,701	06/12/2001	Thomas H. Bienvenu II	LOBO.88280	3770
5251	7590	09/21/2005	EXAMINER	
SHOOK, HARDY & BACON LLP 2555 GRAND BLVD KANSAS CITY,, MO 64108			BLECK, CAROLYN M	
			ART UNIT	PAPER NUMBER
			3626	
DATE MAILED: 09/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/879,701

**Applicant(s)**

BIENVENU ET AL.

**Examiner**

Carolyn M. Bleck

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>21 January 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 12 June 2001. Claims 1-54 are pending. The IDS statement filed 21 January 2003 has been entered and considered.

### ***Claim Objections***

2. Claims 48-53 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 42-47. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

3. Claim 16 is objected to because the claim recites "receiving component" at lines 3 and 7. It is unclear in this claim if the receiving components are different apparatus elements or the same apparatus element.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 11-13, 15-19, 24-30, 37-43, 46-49, and 52-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Dick (US 2001/0053986 A1).

(A) As per claim 1, Dick discloses a method for searching for medical information concerning an individual or group of individuals (Abstract) comprising:

(a) receiving a request for medical records by an insurance company, wherein the request includes pharmaceutical information (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1);

(b) forwarding the requests for patient records over a network to a plurality of pharmacy benefit manager computers, wherein the patient record at the pharmacy benefit manager computers includes pharmaceutical information that is useful in determining the progress of a disease (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1); and

(c) initiating an electronic search of medical records within the pharmacy benefit manager computers and returning a patient record report to an insurance underwriter containing information held by the pharmacy benefit manager computers, wherein the information includes pharmaceutical information for the patient and information about the progress of a disease the patient may have based on the pharmaceutical information (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1).

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(B) As per claim 2, Dick discloses transmitting the pharmaceutical information for the patient and information about the progress of a disease the patient may have based on the pharmaceutical information to the insurance underwriter (par. 18, 32-35, 42, 66).

(C) As per claim 3, Dick discloses querying a plurality of pharmacy benefit managers computers for pharmaceutical records and forwarding all of the information from those records to the requestor (par. 32-33).

(D) As per claim 4, Dick discloses combining all of the information from the plurality of pharmacy benefit managers and other patient record sources into a comprehensive patient record report (par. 32-34).

(E) As per claim 11, Dick discloses requesting healthcare provider information, including the providers DEA number, which is combined into a report with the pharmaceutical information (par. 32-33, 34-35, 83).

(F) As per claims 12 and 15, Dick discloses using information forwarded to the requestor, such as the pharmaceutical information, as information in the analysis of underwriting an insurance policy or determine the risk presented by an insurance applicant (par. 3, 4, 32-33, 42).

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(G) System claims 16-19 and 24-26 repeat the subject matter of method claims 1-4, 11-12, and 15, respectively, as a set of apparatus elements rather than as a series of steps. As the underlying processes of claims 1-4, 11-12, and 15 have been shown to be fully disclosed by the teachings of Dick in the above rejections of claims 1-4, 11-12, and 15, it is readily apparent that the system disclosed by Dick includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-4, 11-12, and 15, and incorporated herein.

(H) Claims 27-30 and 37 repeat the subject matter of method claims 1-4 and 11, respectively, as a computer-readable medium containing instructions for controlling a computer rather than as a series of steps. As the underlying processes of claims 1-4 and 11 have been shown to be fully disclosed by the teachings of Dick in the above rejections of claims 1-4 and 11, it is readily apparent that the method disclosed by Dick includes the computer-readable medium containing instructions for controlling a computer (see par. 41) to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1-4 and 11, and incorporated herein.

(I) As per claims 38-39, Dick discloses a method for searching for medical information concerning an individual or group of individuals (Abstract) comprising:

(a) receiving a request from an insurance underwriter for an individual's medical records by an insurance company, wherein the request includes pharmaceutical information (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1);

(b) forwarding the requests for the patient record over a network to a plurality of pharmacy benefit manager computers, wherein the patient record at the pharmacy benefit manager computers includes pharmaceutical information that is useful in determining the progress of a disease (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1); and

(c) initiating an electronic search of medical records within the pharmacy benefit manager computers and returning a patient record report to an insurance underwriter containing information held by the pharmacy benefit manager computers, wherein the information includes pharmaceutical information for the patient and information about the progress of a disease the patient may have based on the pharmaceutical information (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1).

(J) As per claims 40-41, Dick discloses using information forwarded to the requestor, such as the pharmaceutical information, as information in the analysis of underwriting an insurance policy or determine the risk presented by an insurance applicant (par. 3, 4, 32-33, 42).

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(K) Claims 42, 43, 46-47, 48, 49, and 52-53 repeat the same limitations as claims 1, 3, 12, 15, and 38, and are therefore rejected for the same reasons as those claims, and incorporated herein.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-11, 20-23, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dick (US 2001/0053986 A1) as applied to claim 1, 16, and 27, and further in view of Oscar et al. (US 2001/0037216 A1).

(A) As per claim 5, Dick does not expressly disclose a response including a list of drugs prescribed to the individual. However, Dick expressly discloses returned to the requestor is pharmaceutical information for the patient and information about the progress of a disease the patient may have based on the pharmaceutical information (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1). Oscar discloses after clicking on a button labeled prescription history, providing a response of a list of all of the drugs dispensed to a patient and the date of dispensing (Fig. 8-9, par. 50-51). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Oscar within the method of Dick with the motivation of greatly



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reducing the search time for patient records because the records are providing directly to the requestor (Dick; par. 29-30).

(B) As per claims 8-9, Oscar discloses providing information relating to the drugs in the list such as the drug monograph, drug to drug interactions, and other related information that is well known and can be obtained from various sources (reads on drug indication and drug category) (Fig. 8-9, par. 51). The motivation for combining Oscar within Dick is given above in claim 5, and incorporated herein.

(C) As per claims 6-7, Dick discloses initiating an electronic search of medical records within the pharmacy benefit manager computers and returning a patient record report to an insurance underwriter containing information held by the pharmacy benefit manager computers, wherein the information includes pharmaceutical information for the patient and information about the progress of a disease the patient may have based on the pharmaceutical information (Fig. 1-3, par. 11-12, 28, 32-33, 42, 47, claim 1). Dick does not expressly disclose a response including a list of drugs prescribed to the individual nor the prescription history for a specific duration. Oscar discloses after clicking on a button labeled prescription history, providing a response of a list of all of the drugs dispensed to a patient and the date of dispensing (Fig. 8-9, par. 50-51). In addition, Oscar discloses a list of drugs displayed being for a specific time period based on the recipient's request (Fig. 8-9, par. 50-51). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Oscar

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within the method of Dick with the motivation of greatly reducing the search time for patient records because the records are providing directly to the requestor (Dick; par. 29-30).

(D) As per claim 10, Dick discloses requesting information pertaining to pharmaceutical information (see par. 32-33). Dick does not disclose drug indication information being requested. Oscar discloses providing information relating to the drugs in the list such as the drug monograph, drug to drug interactions, and other related information that is well known and can be obtained from various sources (reads on drug indication and drug category) (Fig. 8-9, par. 51). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Oscar within the method of Dick with the motivation of greatly reducing the search time for patient records because the records are providing directly to the requestor (Dick; par. 29-30).

(E) As per claim 11, Dick discloses requesting healthcare provider information, including the providers DEA number, which is combined into a report with the pharmaceutical information (par. 32-33, 34-35, 83).

(F) Claims 20, 21, 22, and 23 repeat the limitations of claims 5-6 and 9-10, and are therefore rejected for the same reasons as those claims, and incorporated herein.

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(G) Claims 31, 32, 33, 34, and 35-36 repeat the limitations of claims 5-10, and are therefore rejected for the same reasons as those claims, and incorporated herein.

8. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dick (US 2001/0053986 A1) as applied to claim 1, and further in view of Official Notice.

(A) As per claims 13-14, Dick discloses using information forwarded to the requestor, such as the pharmaceutical information, as information in the analysis of underwriting an insurance policy or determine the risk presented by an insurance applicant (par. 3, 4, 32-33, 42). Dick does not expressly state the information can be used in accepting an application for insurance or to obtain further information for insurance purposes.

However, the Examiner respectfully submits that it is well known in the art that the APSs disclosed by Dick in par. 3-4 are used in underwriting an insurance policy and in determining whether to offer the person an insurance policy. It is also well known in the art that the information gained from APSs by insurance companies often do not contain all of the information an insurance company requires to make a proper analysis of the candidate, thus the insurance company must request additional information. At the time the invention was made, it would have been obvious for the insurance actions to be accepting an application and obtaining further information within the method of Dick for the motivation of providing a comprehensive method for insurance underwriters to make decisions.

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9. Claims 44-45 and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dick (US 2001/0053986 A1) as applied to claims 42 and 48.

(A) As per claims 44-45 and 50-51, Dick discloses automatically releasing information from a patient record source, such as PBMs, when a request is forwarded to the PBMs. However, Dick does not explicitly disclose that the request is made automatically as a result of some trigger, such as a laboratory order or result. The Examiner respectfully submits that the use of triggers resulting in the performance of a step, such as sending a request, are well known in the art of database programming. The motivation for using triggers being to greatly reduce the search time for patient records because the records are provided directly to the requestor (Dick; par. 29-30).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches accessing stored ultrasound images and other digital medical images (6,032,120), system and method for automated creation of patient controlled records (US 2002/0026332), networked expert system for the automated evaluation and quality control of medical point of care laboratory measuring data (US 2002/0116224), method and system for providing prescription drug coverage (US 2002/0128863), and system and method for creating prescriptions (US 2002/0143582).

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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (571) 272-6767. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (571) 272-6776.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300 [Official communications]

(571) 273-8300 [After Final communications labeled "Box AF"]

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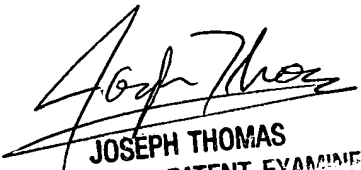
(571) 273-6767 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to the Knox Building, Alexandria, VA.

CB

CB

September 15, 2005

  
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SUPERVISORY PATENT EXAMINER  
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